REMARKS

Claims 1-7 and 14-30 are pending in the application.

Applicant thanks the Examiner for the telephone conference conducted on October 5, 2004 with counsel Linda Shapiro. During that conference, the Examiner indicated that he interpreted "extending ... only partly" to be sufficiently broad to encompass a width-wise die-cut, as well as a depth-wise die-cut. Applicant's counsel agreed to review the specification and make amendments consistent therewith to make explicit that "extending ... only partly" refers to a depth-wise die-cut.

By the foregoing Amendment, claims 1, 2, 16, 17, 24, and 25 are amended. Claims 1, 16, and 24 are amended to add the limitation from claims 2, 17, and 25, respectively, that the die-cut extends "depth-wise ... only partly into said patch of magnet material," and to change "die-cut card" to "die-cut card area" in the "holding means" limitation. Claims 2, 17, and 25 are amended to delete the limitation added to claims 1, 16, and 24, respectively, that the die-cut "extends only partly into said patch of magnetic material."

Support for the limitation regarding the die-cut extending "depth-wise" is found in paragraph 0030 and Figure 4 of the application. It is well-settled that claim limitations must be interpreted in light of the specification. It is respectfully submitted that, when interpreted in light of paragraph 0030 and Figure 4, the limitation that the die-cut extends "only partly into said patch of magnet material" must be interpreted as referring only to a depth-wise die-cut. Likewise, the limitation that the die-cut extends "through said polyfilm patch" must be interpreted as referring only to a depth-wise die-cut. It is therefore also respectfully submitted that the addition of "depth-wise" to claims

1, 16, and 24 merely makes explicit what was already implicit in the claims, such that the scope of the claims is not changed.*

These changes are believed not to introduce new matter, and entry of the Amendment is respectfully requested.

Based on the above Amendment and the following Remarks, Applicant respectfully requests that the Examiner reconsider all outstanding objections and rejections, and withdraw them.

Rejection under 35 U.S.C. § 112, ¶ 2

In paragraph 1 of the Office Action, claims 1-7, 14, and 15 were rejected under section 112, second paragraph, of the U.S. patent statute as being indefinite. This rejection is believed to be overcome by changing "die-cut card" to "die-cut card area" in the "holding means" limitation, as suggested by the Examiner. The same amendment has been made to independent claims 16 and 24.

Rejections under 35 U.S.C. § 103

1. Claims 1-6 and 15-21

In paragraph 3 of the Office Action, claims 1-6 and 15-21 were rejected under section 103(a) as being unpatentable over newly-cited U.S. Patent No. 6,533,325 to Steidinger in view of U.S. Patent No. 6,153,279 to Charley. This rejection is respectfully traversed on the basis that the references do not teach or suggest the invention as recited in claims 1-6 and 15-21.

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* It is noted that paragraph 0028 describes the cutting die as having slits, as well known in the art, to form holding tabs 24 along the die-cut, as shown in Figure 5. The amendments to claims 1, 16, and 24 do not preclude the presence of such holding tabs, as such holding tabs are in addition to the uncut region that remains in the patch of magnet material as a result of the partial depth-wise die-cut.

The invention as recited in claims 1 and 16 is directed to a carrier sheet comprising, among other things, a single paper sheet having front and rear faces, a thin flexible patch of magnet material adhesively secured on the rear face of the paper sheet and extending over the card area of the sheet, and a die-cut in the paper sheet delineating the contour of the card area and extending depth-wise only partly into the patch of magnet material. A polyfilm patch is adhered over the card area on the front face of the paper sheet.

The Office Action relies on both Figure 1 and Figure 4 of Steidinger. Figures 1 and 4 both illustrate integral card business forms. As defined by Steidinger, an integral card business form is one in which "at least one layer of a card is made of the form material itself" (column 1, lines 58-59). In the "Background of the Invention," Steidinger describes various types of integral card business forms. In most integral card business forms, "a portion of the form receives at least one plastic laminate on at least one surface of the form (although integral cards may also be provided without laminates)." Column 1, lines 60-64. In a perforated integral card business form:

> The form and laminate are then perforated in a closed path within the perimeter of the laminate to define an integral card. The central portion within the perimeter of the die-cut perforation defines an integral card portion; and the perimeter portion outside the die-cut and within the boundary of the lamination defines a border or frame portion.... The perforation of prior art perforated integral cards (as distinguished from "peel-out" cards, to be described below) typically extends continuously around the intended perimeter of the card and provides ties or connections between the card portion and the border portion.

Column 2, lines 4-19. In contrast, in a "peel-out" integral card business form:

> proprietary material provide a peel interface to hold the card in the business form until use. As opposed to rupturing perforations to remove the card out from the die-cut opening in the form, "peel-out" approaches provide an integral card which can be removed by peeling the card out of the die-cut opening using a special series

of laminates and adhesives to obviate the use of perforations. The special series of laminates consists of

(i) a backer ply;

(ii) a plastic laminate;

(iii) an adhesive or other means to bond the backer ply to the plastic laminate while permitting the two to be separated by a peeling action (the peel interface); and

(iv) a pressure-sensitive adhesive to bond the plastic laminate to the form.

The special series of laminates are applied to a portion of the form sheet and a perimetrically continuous (or "closed") die-cut defines the card portion and a frame portion. In this case, however, the die has a uniform cutting edge, not a notched perforator edge; and it penetrates the form and plastic laminate, but not the backer layer. The backer layer is the tying or connecting medium which secures the card in place during subsequent processing. The die-cut card portion is secured to the backer ply until it is peeled out.

Column 2, lines 45-65. This construction of the "peel-out" integral card business form is illustrated in Figure 1.

Steidinger's Figure 1 illustrates a prior art "peel-out" integral card business form of the type described in Steidinger's "Background of the Invention," whereas Figure 4 illustrates an "integral card" business form that differs from the prior art "peel-out" integral card business form in that the peelable adhesive layer 18 and the backer (17) of the prior art form are deleted (see column 7, lines 12-16), and the die-cut is in the form of a microperforation (column 7, lines 50-52). That is, the integral card business form illustrated in Figure 4 is akin to the perforated integral card business form described in the "Background of the Invention."

In the integral card business form illustrated in both Figures 1 and 4, the cutting die (19) (and thus the die-cut) extends all the way through the top laminate (12, 112), the form ply (11, 111), the

adhesive (13, 113) bonding the top laminate (12, 112) to the top surface of the form ply (11, 111), the bottom laminate (15, 115), and the adhesive (16, 116) bonding the bottom laminate (15, 115) to the bottom surface of the form ply (11, 111). With respect to the integral card business form illustrated in Figure 1, Steidinger teaches that if the die (19) does not penetrate all the way through the bottom laminate (15, 115) down to the upper surface of the backer (17), the peel function will be impaired; but if the die (19) penetrates too far and cuts into the upper surface of the backer (17), the card portion (20) may fall out prematurely. Column 6, lines 36-49.

Charley discloses a label construction in which the contours of the magnet (12), the printed material (14), and the transparent covering (18) are nearly co-extensive, with the perimeter of the magnet (12) extending slightly beyond the printed material (14) and the transparent covering (18). The magnet (12) is pre-cut, and Charley's label is constructed in such a way that printing is applied to the label stock or paper first, the label stock or paper being cut to size or stripped before being adhered to the pre-cut magnet (12).

There are two important distinctions between Charley's label and all of the integral card business forms described by Steidinger:

(1) In all of the business forms described by Steidinger, the card is integral with the form material, whereas in Charley's label, the printed material (14) is not integral with a form or paper sheet or carrier sheet, or with the substrate to which the magnet (12) is applied, but is instead separate from the substrate S to which the magnet (12) is adhered; and

(2) In all of the business forms described by Steidinger, the die-cut extends through all of the layers down to the upper surface of the backer (17), whereas in Charley's label, because the

printed material (14) is separate from the substrate S to which the magnet 12 is adhered, there is no die-cut in any form, paper sheet, carrier sheet, or substrate to extend into the magnet 12.

In the Office Action, the rejections based on the combination of Steidinger and Charley are justified by reasoning that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Steidinger's carrier sheet with a paper sheet having a flexible laminate patch made of magnetic material as taught by Charley for the purpose [of, *sic*] removably attaching the card to an alternative surface."

In view of the distinctions between Charley's label and all of the integral card business forms described by Steidinger, it is respectfully submitted that there would be no motivation to modify any of the integral card business forms described by Steidinger to incorporate a flexible magnet from a non-integral label, as taught by Charley.

Even assuming for the sake of argument the necessary motivation, it is further respectfully submitted that the addition of a flexible magnet as taught by Charley to the integral card business forms described by Steidinger would not result in the invention as recited in the independent claims, and also would render the integral card business forms unusable for their intended purpose.

Charley teaches positioning the magnet (12) between the bottom surface of the printed material (14) and the top surface of a clear base material (20), which clear base material (20) is adhered to a clear film 24, which in turn is attached to an adhesive backing 26 covered by a liner 28. The magnet (12) is pre-cut.

Because Steidinger does not employ a magnet patch, Steidinger cannot teach or suggest a die-cut "extending depth-wise ... only partly into said patch of magnetic material" as required by claims 1. Because Charley's magnet is pre-cut before the application of the printed material, Charley cannot teach or suggest a die-cut "extending depth-wise ... only partly into said patch of magnetic material" as required by claims 1. Therefore, Steidinger in view of Charley cannot teach or suggest a die-cut "extending depth-wise ... only partly into said patch of magnetic material" as required by claims 1.

Further, applying Charley's teachings to the integral card business forms described by Steidinger would require placing Charley's magnet (12) between the bottom surface of the form layer (11, 111) and the adhesive (16, 116) adhering the bottom laminate (15, 115) to the bottom surface of the form layer (11, 111), in the area under the removable card portion (20, 120), with the contour of the magnet 12 being larger than the contour of the card portion (20, 120). Any other arrangement (for example, the magnet 12 being interposed between the bottom laminate (15, 115) and the backer (17)) would not satisfy the claim requirement that the "thin flexible patch of magnet material [be] adhesively secured on a rear face of said paper sheet." Steidinger's teachings regarding the die-cut then come into play. As discussed above, Steidinger teaches that the die (19) must penetrate down to, but not into, the upper surface of the backer (17). Because Charley's magnet (12) would be interposed between bottom surface of the form layer (11, 111) and the backer (17), the die-cut would have to extend depth-wise completely through Charley's magnet (12) in order to follow Steidinger's teaching that the die (19) must penetrate down to, but not into, the upper surface of the backer (17). However, all of the independent claims require *the die-cut to be "extending depth-wise ... only partly into said patch of magnet material,"* not *through* it.

Steidinger also teaches (at column 6, lines 50-61), with respect to the type of integral card business form illustrated in Figure 1:

> The combination of relativley [*sic*] hard top laminate 12 and bottom laminate 15, and soft adhesives 13, 16 (and sometimes 18), makes it more difficult to die-cut the card portion 20 without also cutting or scoring the backer 17. Sometimes, the flank angle α (FIG. 1) of the die 19 must be reduced to penetrate the relatively thick sandwich of materials. This not only adds cost for producing a special die, but also weakens the die edge 23, reducing die life. The die height 24 must be very accurately controlled (to within 0.1 mil), all the way around the perimeter of the die edge to assure proper die-cutting. This also adds cost to the die and to the process of manufacturing cards.

Interposing Charley's magnet (12) between the form ply (11, 111) and the bottom laminate (15, 115) would only exacerbate the problems identified by Steidinger. In fact, the present application recognizes (in paragraphs 0011, 0030, and 0033) that it is preferable that the die-cut only extends partly into the patch of magnet material in order to greatly prolong the use of the cutting die. It is therefore respectfully submitted that a person of ordinary skill in the applicable art would be led away by Steidinger's teachings from interposing Charley's magnet (12) between the form ply (11, 111) and the bottom laminate (15, 115) by:

- the difficulty of die-cutting through Charley's magnet (12), in addition to the top laminate (12, 112), the form ply (11, 111), the adhesive (13, 113) bonding the top laminate (12, 112) to the top surface of the form ply (11, 111), the bottom laminate (15, 115), the adhesive (16, 116) bonding the bottom laminate (15, 115) to the bottom surface of the form ply (11, 111)
- the further adjustments to the flank angle of the die that would be necessitated by the addition of another layer
- the reduction to the die life resulting from the addition of another layer

In view of the foregoing, it is respectfully submitted that the invention as recited in claims 1-6 and 15-21 is patentable over Steidinger in view of Charley, and that the rejection should be withdrawn.

2. Claims 7, 14, and 22-30

In paragraph 4, claims 7, 14, and 22-30 were rejected under section 103(a) as being unpatentable over Steidinger in view of Charley, and further in view of previously-cited U.S. Patent No. 6,019,280 to Peterson. This rejection is respectfully traversed for the reasons stated above with respect to the rejection of claims 1-6 and 15-21.

In the Office Action, Peterson was cited as teaching foldable panels. Peterson does not compensate for the deficiencies in the teachings of Steidinger and Charley as discussed above. Consequently, it is respectfully submitted that the invention as recited in claims 7, 14, and 22-30 is patentable over Steidinger in view of Charley and further in view of Peterson, and that the rejection should be withdrawn.

Conclusion

All objections and rejections have been complied with, properly traversed, or rendered moot. Thus, it now appears that the application is in condition for allowance. Should any questions arise, the Examiner is invited to call the undersigned representative so that this case may receive an early Notice of Allowance.

Favorable consideration and allowance are earnestly solicited.

Respectfully submitted,

JACOBSON HOLMAN PLLC

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By: _____

Allen S. Melser
Registration No. 27,215

Customer No. 00,136
400 Seventh Street, N.W.
Washington, D.C. 20004
(202) 638-6666